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<h1 style="margin:0;">FEE TRANSMITTAL for FY 2004</h1> <p style="font-size: small; margin: 5px 0;">Effective 10/01/2003. Patent fees are subject to annual revision.</p>	Complete if Known	
	Application Number	09/640,822
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27	Filing Date	August 17, 2000
	First Named Inventor	Gers-Barlag et al.
	Examiner Name	Lauren Q. Wells
TOTAL AMOUNT OF PAYMENT (\$)	Art Unit	1619
	Attorney Docket No.	Beiersdorf 637.1
(\$)	\$330.00	

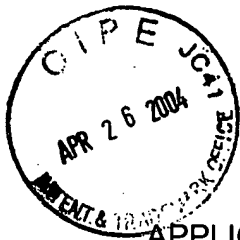
<p>METHOD OF PAYMENT (check all that apply)</p> <p><input type="checkbox"/> Check <input type="checkbox"/> Credit card <input type="checkbox"/> Money Order <input type="checkbox"/> Other <input type="checkbox"/> None</p> <p><input checked="" type="checkbox"/> Deposit Account:</p> <p>Deposit Account Number: 14-1263</p> <p>Deposit Account Name: Norris, McLaughlin & Marcus</p> <p>The Director is authorized to: (check all that apply)</p> <p><input checked="" type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments</p> <p><input checked="" type="checkbox"/> Charge any additional fee(s) or any underpayment of fee(s)</p> <p><input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.</p>	<p>FEE CALCULATION (continued)</p> <p>3. ADDITIONAL FEES</p> <table border="1" style="width:100%; border-collapse: collapse; font-size: x-small;"> <thead> <tr> <th colspan="2">Large Entity</th> <th colspan="2">Small Entity</th> <th rowspan="2">Fee Description</th> <th rowspan="2">Fee Paid</th> </tr> <tr> <th>Fee Code</th> <th>Fee (\$)</th> <th>Fee Code</th> <th>Fee (\$)</th> </tr> </thead> <tbody> <tr><td>1051</td><td>130</td><td>2051</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>1052</td><td>50</td><td>2052</td><td>25</td><td>Surcharge - late provisional filing fee or cover sheet</td><td></td></tr> <tr><td>1053</td><td>130</td><td>1053</td><td>130</td><td>Non - English specification</td><td></td></tr> <tr><td>1812</td><td>2,520</td><td>1812</td><td>2,520</td><td>For filing a request for <i>ex parte</i> reexamination</td><td></td></tr> <tr><td>1804</td><td>920*</td><td>1804</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr> <tr><td>1805</td><td>1,840*</td><td>1805</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr> <tr><td>1251</td><td>110</td><td>2251</td><td>55</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>1252</td><td>420</td><td>2252</td><td>210</td><td>Extension for reply within second month</td><td></td></tr> <tr><td>1253</td><td>950</td><td>2253</td><td>475</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>1254</td><td>1,480</td><td>2254</td><td>740</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>1255</td><td>2,010</td><td>2255</td><td>1,005</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>1401</td><td>330</td><td>2401</td><td>165</td><td>Notice of Appeal</td><td></td></tr> <tr><td>1402</td><td>330</td><td>2402</td><td>165</td><td>Filing a brief in support of an appeal</td><td style="text-align: center;">330.00</td></tr> <tr><td>1403</td><td>290</td><td>2403</td><td>145</td><td>Request for oral hearing</td><td></td></tr> <tr><td>1451</td><td>1,510</td><td>1451</td><td>1,510</td><td>Petition to institute a public use proceeding</td><td></td></tr> <tr><td>1452</td><td>110</td><td>2452</td><td>55</td><td>Petition to revive - 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SUBMITTED BY		<i>Complete (if applicable)</i>			
Name (Print/Type)	Howard C. Lee	Registration No. (Attorney/Agent)	48,104	Telephone	212-808-0700
Signature	<i>Howard C. Lee</i>	Date	April 26, 2004		

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Attorney Docket No. Beiersdorf 637

APPLICANT: Gers-Barlag et al.

TITLE: Hydrous Cosmetic or Pharmaceutical Sticks

USSN: 09/640,822

FILED: August 17, 2000

EXPRESS MAIL CERTIFICATE

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Date of Deposit April 26, 2004

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NORRIS, McLAUGHLIN & MARCUS, P.A.

By Agata Glinska
Agata Glinska



Beiersdorf 637.1-HCL
100718-197
6713-Dr. Wi-ar

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANTS : GERS-BARLAG et al.
SERIAL NO. : 09/640,822
FILED : 17 August 2000
FOR : HYDROUS COSMETIC OR PHARMACEUTICAL STICKS
ART UNIT : 1619
EXAMINER : Lauren Q. Wells

25 February 2004

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 1.192

SIR:

This is an appeal from the final rejection dated 25 November 2003.

(1) REAL PARTY IN INTEREST

The real party in interest is **Beiersdorf AG** by virtue of an assignment recorded on at Reel 011148, Frame 0047 (Recorded on 17 August 2000).

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

(3) STATUS OF CLAIMS

Claims 16-31 stand finally rejected.

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(4) STATUS OF AMENDMENTS

All amendments are believed to have been entered.

(5) SUMMARY OF INVENTION

The present invention relates to cosmetic or dermatological stick preparation, which is a finely disperse water-in-oil emulsion, comprising

- a) an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,
 - b) a water phase,
 - c) at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and
 - d) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.
- (see also claim 16). Support for claims 16-31 can be found throughout the specification and substantially the same as originally filed claims 1-10.

(6) ISSUES

The sole issue to be decided is whether claims 16-30 are obvious over Fänger et al. (U.S. Patent 6,153,204) in view of Msika et al. (U.S. Patent 5,939,054).

(7) GROUPING OF CLAIMS

Claims 16-28 and 31 are directed toward stick preparations. Claim 29 is directed toward a method of preparing a Pickering emulsion and claim 30 is directed toward a method of treating the skin using the preparation of claim 16.

Claims 17-20, 23-30 and 31 stands or fall with the rejection of claim 16.

The Msika reference addresses the equivalence for substituting a (Quaternium 14; 18 hectorite) for an aluminum silicate and as such claims 21 and 22 can be considered on their own merits.

(8) ARGUMENT

Table of Contents

I.	Question to Be Answered	3
II.	Basic Considerations Which Apply to Obviousness Rejections	3
A.	As a Whole Considerations and Impermissible Hindsight Reconstruction	3
B.	No Teaching, Suggestion or Motivation to Select the Necessary Elements from Fänger and Msika Modify Fänger/Msika References to Account for the Differences Between Fänger/Msika and Appellants' Claimed Invention	6
C.	No Reasonable Expectation of Success	
III.	Conclusion	

I. **Question to Be Answered**

The basic disagreement between the appellants' and the Examiner's position on the obviousness of the claims over Fänger and Msika is over what the prior art would teach to one of ordinary skill in the art at the time the invention was made when not having the appellants' claims to act as a blueprint for the invention. If the Board accepts the appellants' position, then the rejection should be withdrawn and the claims allowed.

II. **Basic Considerations Which Apply to Obviousness Rejections**

MPEP 2141 recites in part:

"When applying 35 U.S.C. 103, the following tenets of patent law **must be** adhered to:

- (A) The claimed invention **must be** considered as a whole;
- (B) The references **must be** considered as a whole and **must suggest** the desirability and thus the obviousness of making the combination;
- (C) The references **must be** viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined

Hodosh v. Block Drug Co., Inc. 786 F.2d 1136, 1143, n.5, 229 USPQ 187 n.5 (Fed. Cir. 1986)." (emphasis added)

(A) **As a Whole Considerations and Impermissible Hindsight Reconstruction**

While it is well known that patents are relevant as prior art for all they contain (see MPEP 2123), this still does not absolve the Examiner from considering the appellants' claimed invention and the references cited "as a whole" (see MPEP 2141.02) Moreover, when engaging in this as a whole consideration, the references cannot be viewed with the benefit of hindsight reconstruction. MPEP 2142 states in part:

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (emphasis added)

The chart and explanation below served to describe and compare the fundamental basis of the inventions described by the appellants' claims and the prior art:

Appellant's claim 16	Fänger et al. claim 1	Msika abstract
<p>Cosmetic or dermatological stick preparation, which is a finely disperse water-in-oil emulsion, comprising</p> <p>a) an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,</p> <p>b) a water phase,</p> <p>c) at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and</p> <p>d) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.</p>	<p>A method for reducing the stickiness of a cosmetic or topical dermatological preparation, said method comprising incorporating in said cosmetic or topical dermatological preparation an amount of a compound which is sufficient to reduce the stickiness of said cosmetic or topical dermatological preparation, wherein said compound is a hydrophilic starch esterified with one or more n-octenylsuccinate radicals, which has the formula:</p> <p>starch-X_n</p> <p>wherein starch represents a hydrophilic starch;</p> <p>X represents the radical:</p> $\begin{array}{c} \text{O} \\ \parallel \\ \text{---O---C---CH---C---C---C---C---CH}_3 \\ \quad \quad \quad \quad \quad \quad \quad \quad \quad \quad \quad \quad \\ \quad \quad \quad \text{H}_2 \quad \quad \quad \text{H} \quad \quad \quad \text{H}_2 \quad \quad \quad \text{H}_2 \\ \quad \quad \quad \\ \quad \quad \quad \text{CH}_2 \\ \quad \quad \quad \\ \quad \quad \quad \text{C=O} \\ \quad \quad \quad \\ \quad \quad \quad \text{O}^\ominus \\ \quad \quad \quad \text{Na}^\oplus \end{array}$ <p>and n represents a number ≥1.</p>	<p>A sunscreen composition containing a synergic mixture of titanium and/or zinc oxide particles, characterized in that said particles are incorporated in paste-forming oils and/or esters and/or fatty alcohols and/or ethers selected so as to provide a wetting point of the incorporated titanium oxide particles and of the incorporated zinc oxide particles lower than about 5 and a flow point of said incorporated particles lower than about 30.</p> <p>(can be water-in-oil emulsion in the form of sticks)</p>
<p>Additional comments</p>	<p>Additional comments</p>	
<p>Specification discloses optional combination of modified phyllosilicates with starch n-octenyl succinate (see page 15, lines 12-21)</p>	<p>Fänger does teach stick preparations using starch n-octenyl succinate but only in the absence of water as in their lipsticks (see Example 13 and col. 3, lines 23-26) or as water-in-oil emulsions which have levels of emulsifier well in excess of the applicants claimed levels (see Example 14 - polyglyceryl-3-dioleate (3.50%) is an emulsifier)</p>	

As knowledge of the applicants' disclosure (which includes their claims) must be put aside in determining whether the appellants' claims are *prima facie* obvious over the prior art, the appellants' fail to see how one of ordinary skill in the art would arrive at the appellants' claimed invention when considering the references as a whole even before addressing considerations of desirability to combine or modify the teaching of the references and having a reasonable expectation of success. (As a practical exercise, cover the column containing appellants' claim 16 and ask another Board member who is unfamiliar with the prosecution history to draft a claim which is obvious in light of the Fänger and Msika reference; appellants' believe this claim would bear little resemblance to the appellants' claims.)

Applying this standard to the Fänger and Msika references, the appellants fail to see how the person of ordinary skill in the art without knowledge of the applicants disclosure would have arrived at the appellants' invention given that the as a whole teaching of Fänger appears to be directed to reducing stickiness of already known composition by adding starch n-octenyl succinate and Msika is directed toward a synergic mixture of titanium and/or zinc oxide particles. (As an illustrative exercise: Cover the column containing the description of Appellants' claim 16 in the chart above and show the remaining columns to a person unfamiliar with the prosecution history of this application. Appellants believe that person would not draft a claim which approximates the appellants' claim 16).

The Examiner's characterization of the Fänger reference has been misleading throughout the prosecution as it indicates a level of similarity with the appellants' claimed invention which simply does not exist. The above chart indicated in bold some of the key elements of the appellants' invention which included: (1) stick preparation; (2) water-in-oil emulsion; (3) modified phyllosilicate pigment with amphiphilic character; (4) at most 0.5% by weight of one or more emulsifiers. This is a collective package of elements which ***must always be simultaneously present*** in the appellants' invention.

There is no such recognition for this collective package of elements in the Fänger reference. The Examiner must resort to improper picking and choosing in order to collect the elements necessary to approximate the appellants' invention.

However it is well known that, "virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to

defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457.

(B) No Teaching, Suggestion or Motivation to Select the Necessary Elements from Fänger and Msika

The appellants' believe that the Fänger reference fails to teach at a minimum the limitation of the amount of emulsifier as represented by appellants' claims 16 and 17. However, even if this point were given to the Examiner, there is still no teaching, suggestion or motivation to pick and choose among the teachings of Fänger to even attempt to approximate the applicants' invention.

It has long been established that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965), *see also Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002) - "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *See Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.").

Fänger teaches that the stickiness of previously known cosmetic or topical dermatological preparations could be reduced by incorporating a hydrophilic starch esterified with one or more n-octenylsuccinate radicals. There is no recognition that Fänger's cosmetic or topical dermatological preparation would simultaneously have the elements of the appellants' invention (e.g. (1) stick preparation; (2) water-in-oil emulsion; (3) modified phyllosilicate pigment with amphiphilic character; (4) at most 0.5% by weight of one or more emulsifiers). At best, Fänger only conceives of having one or two of these elements

present in their invention at any given time and there is no teaching, suggestion or motivation from Fänger or Msika which would lead one of ordinary skill in the art to modify the core of Fänger's invention to incorporate all of the elements as the appellants' have done.

With regard to claims 21 and 22, Msika appears to be primarily relied upon for the substitution of quaternium 14 and 18 hectorite for aluminum silicate as the phyllosilicate. However, both examples which use this phyllosilicate **are not** sticks based on water-in-oil emulsions (see col. 12 - "Anhydrous Compact for Protecting and Correcting the Complexion" and "Total Sunblock Stick"). In addition, this reference also teaches that when their compositions are emulsions of the water-in-oil type "...the concentration of emulsifying system is between 4 and 35% by weight with respect to the total weight of the emulsion" (see col. 4, lines 32-37). As the inventive step of Msika is the synergic mixture of titanium and/or zinc oxide particles, there is no reason to select the isolated teaching about the use of quaternium 14 and 18 hectorite into the teaching of Fänger especially given that the use of these compounds are for preparations which are outside the scope of the appellants' claimed invention.

(C) No Reasonable Expectation of Success for the Combination

Even if the Examiner were permitted to ignore "as a whole" considerations and to pick whatever elements were needed to sustain a rejection, there is no evidence which would hint a successful combination of all of the elements of the applicants' invention. The closest embodiments to the appellants' invention are Example 13 and 14 of the Fänger reference. Both of these examples do not have ANY pigment particle much less a modified phyllosilicate pigment particle. Moreover, Example 13 is a stick but is not water-in-oil emulsion as it is lacking an aqueous phase and Example 14, while being a water-in-oil emulsion stick, can only be formulated by using 3.50% of polyglyceryl-3-dioleate, a known emulsifier. Collectively, these Examples would have suggested to one of ordinary skill in the art that use of hydrophilic starch esterified with one or more n-octenylsuccinate radicals in a stick preparation would've required an excess of emulsifier for a water-in-oil emulsion stick or that low emulsifier or emulsifier-free sticks could only have been achieved by removing the water phase. The examples from Msika cited above merely repeat the same deficiencies found in the Fänger reference.

The Examiner has not produced any evidence which contradicts this position. As a holding of *prima facie* obviousness is based on a preponderance of evidence standard ("more likely than not"), the appellants' hold that the Examiner has not met the evidentiary burden to sustain her obviousness rejection.

(9) CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Honorable Board reverse the final rejection of claims 16-31.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231 on the date indicated below:

Date: **26 April 2004**

By *Agata Glinska*
Agata Glinska

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NORRIS, McLAUGHLIN & MARCUS, P.A.

By _____

Date _____

(10) APPENDIX - CLAIMS ON APPEAL

16. Cosmetic or dermatological stick preparation, which is a finely disperse water-in-oil emulsion, comprising
 - a) an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,
 - b) a water phase,
 - c) at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and
 - d) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.
17. Preparation according to Claim 16, wherein it is emulsifier-free.
18. Preparation according to Claim 16, wherein the water phase content is from 15 to 60% by weight, based on the total weight of the preparations.
19. Preparation according to claim 16, wherein further cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients are present.
20. Preparation according to claim 16 or 19, wherein the content of modified phyllosilicate pigment particles used is between 0.1% by weight and 30% by weight, based on the total weight of the preparations.
21. Preparation according to claim 16 or 19, wherein the modified phyllosilicate pigment particle(s) is/are chosen from the group which includes modified smectites, modified bentonites, modified montmorillonites and modified hectorites.
22. Preparation according to claim 21, wherein the modified phyllosilicate pigment particle(s) is/are a modified hectorite selected from the group consisting of stearylalkonium hectorite and quaternium-18 hectorite.

23. Preparation according to claim 16 or 19, wherein, in addition to one or more modified phyllosilicate pigment particle(s), (a) further pigment(s) are present which are selected from the group consisting of modified polysaccharide, microfine polymer particles, boron nitride and micronized, inorganic pigments where the pigments can be present either individually or in a mixture.
24. Preparation according to claim 23, wherein the micronized, inorganic pigments is/are an amphiphilic metal oxide(s).
25. Preparation according to claim 24, wherein the amphiphilic metal oxide(s) are selected from the group consisting of titanium dioxide, zinc oxide, iron oxides or iron mixed oxides, silicon dioxide and silicates.
26. Preparation according to claim 16 or 19, wherein it is in the form of a make-up and/or cosmetic stick, and additionally comprises at least one dye and/or one color pigment.
27. Preparation according to claim 26, wherein the make-up and/or cosmetic stick form is selected from the group consisting of eyebrow pencil, kohl pencil, eyeshadow pencil, eyeliner pencil, concealer stick, powder stick and lipstick.
28. Preparation according to claim 16 or 19, wherein it comprises one or more additives or active ingredients selected from the group consisting of astringents, antioxidants, UV filter substances, antimicrobial substances and substances effective against acne.
29. Method for the preparation of Pickering emulsion sticks, wherein modified phyllosilicate pigment particles are dispersed in the oil phase, which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C, and, optionally, cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, with uniform stirring and optionally with heating, and, during the uniform stirring, the water phase, which, optionally comprises cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, is mixed with the oil phase.
30. A method of treating the skin comprising applying to the skin a preparation according to claim 16.

31. Cosmetic or dermatological stick preparation, which is a finely disperse water-in-oil emulsion, consisting essentially of
- a) an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C,
 - b) a water phase,
 - c) at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and
 - d) at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.